

**REMARKS**

Claims 1-21 and 27-32 are pending. Applicants thank the Examiner for the Personal Interview of May 19, 2004.

I. Drawing, Specification and Claim Amendments

The specification has been amended to particularly present subject matter shown in the originally filed Fig. Specifically, as the surface element 1 is shown as having a tongue on one edge and a groove on a second end, the specification has been amended to describe these features. Additionally, the amended drawing figure includes identifiers for the tongue and groove, i.e., 3' and 3", respectively. The independent claims have been amended to recite this feature, which was found in dependent claim 22. No new matter has been entered. Claims 27-29 are supported by the originally filed Fig., and claims 30 and 31 are supported by the last full paragraph on page 6 of the present specification.

II. 35 USC § 112

Claims 18 and 20 stand rejected under 35 USC § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim that which is considered the invention. The Office Action takes issue with the alternative listing of methods by which the wear layer may be provided. In response, claims 18 and 20 have been amended to show how the claims are correct recitations of Markush groupings. See MPEP § 2173.05(h). Reconsideration is respectfully requested.

III. Chen et al.

Claims 18, 20, 22 and 25 stand rejected under 35 USC § 103(a) as allegedly being unpatentable over Mckee (U.S. Patent No. 5,568,391) in view of Chen et al. (U.S. Patent No. 6,617,009). However, as detailed in the concurrently filed Declaration of Ingvar Sylegard under 327 CFR § 1.131, the Applicants conceived of the subject matter recited the claims of this application prior to the filing date of Chen et al., i.e., December 14, 1999, and were diligent until

the filing of the priority document, i.e., SE 9904781-3 on December 23, 1999. Thus, Applicants respectfully present that Chen et al. is not a proper references against the present claims of the present application.

IV. 35 USC § 102

Claims 1, 3, 4, 7-13, 17, 21, and 23 stand rejected under 35 USC § 102(b), as allegedly being unpatentable over Mckee and/or Gerber et al (U.S. Patent No. 5,443,680). The Office Action asserts the respective reference teaches each feature recited by the rejected claims. However, in light of the above-amendments, reconsideration is respectfully requested.

In particular, the Office Action states, "Mckee however does not teach the use of tongue and grooved elements." Since each of claims 1, 3, 4, 7-13, 17, and 21 (claim 23 having been cancelled) recite the presence of at least one of a tongue and a groove on the edge of the surface elements, Applicants respectfully present that Mckee cannot expressly anticipate any of the pending claims. Since Gerber et al. is similarly deficient, neither can Gerber et al. expressly anticipate any of the pending claims.

Moreover, as discussed at the Personal Interview, Gerber et al. and Mckee relate to mosaics, i.e., a pattern formed from different colored units, wherein the patterns are defined at the edges of the groupings of colored units. While Mckee may teach that the tiles of the mosaic can contain more than one color, such color is produced by blending, and cannot permit the decor to cover more than one surface element, as such is not a mosaic.

V. 35 USC § 103

Claims 2, 5, 6, 14-16, 19, 20, and 24-26 stand rejected under 35 USC § 103(a) as allegedly being unpatentable over Mckee or Gerber et al., alone or in view of Newton et al. (U.S. Patent No. 6,504,559). However, as neither Mckee, Gerber et al. nor Newton et al. teaches or suggests the use of tongue and grooved elements, reconsideration is respectfully requested. See Office Action, paragraph bridging pages 8 and 9.

VI. Conclusion

In view of the above, it is respectfully submitted that all objections and rejections are overcome. Thus, a Notice of Allowance is respectfully requested.

Respectfully submitted,



Thomas P. Pavelko

TPP/EPR

Attorney Docket No.: TPP 31349

Registration No. 31,689

STEVENS, DAVIS, MILLER & MOSHER, L.L.P.  
1615 L Street, N.W., Suite 850  
Washington, D.C. 20036  
Telephone: (202) 785-0100  
Facsimile: (202) 408-5200 or (202) 408-5088

Date: May 28, 2004